

AUS920010628US1

REMARKS

Figures 1-4 are stand objected to as containing improper text and lines that may affect clarity when reproduced. Applicants filed formal drawing on December 2, 2003. Examiner Gart has not received those formal drawings. In an effort to move the case forward, Applicants submit with this response a new set of formal drawings. The objection should be withdrawn.

Claims 1-33 stand rejected under 35 U.S.C 102(e) as being anticipated by Mourad *et al.* (U.S. Patent Application No. 2003/0135464). To anticipate claims 1-33 Mourad must meet two basic criteria. The first criteria for anticipation is that Mourad must disclose each and every element as set forth in the claims 1-33. *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). The second basic requirement for anticipation is that Mourad must be an enabling disclosure of claims 1-33. *In re Hoeksema*, 399 F.2d 269, 273, 158 USPQ 596, 600 (CCPA 1968).

Mourad Does Not Disclose Each and Every Element of Independent Claim 1

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). To anticipate independent claim 1 within the meaning of *Verdegaal Bros.*, Mourad must disclose each and every element of the claim as those elements are set forth in claim 1 itself. Mourad does not disclose each and every element of independent claim 1. Applicant's therefore traverse the rejection and request reconsideration of the rejection of claim 1.

Currently amended independent claim 1 claims "a method of online shopping comprising the steps of: purchasing an electronic item from a merchant web site . . . wherein the purchasing is carried out by use of a client shopping cart that collects item information

AUS920010628US1

from the merchant web site prior to checkout . . . downloading, to the client, the electronic item through the merchandise pickup facility on the client; and installing the electronic item through the merchandise pickup facility on the client.” Mourad discloses a method of digital content distribution using web broadcasting services generally and more particularly, Mourad discloses a system for downloading encrypted digital content. *See for example*, Mourad paragraph 0009, paragraph 0020, paragraph 0902. The Office Action states that Mourad discloses a client shopping cart at paragraphs 0282 and 0902. The cited paragraphs disclose adding an item to a shopping cart maintained by an Electronic Digital Content Store. The cited paragraphs also disclose a mixture of electronic and physical media selections in the shopping cart. The cited paragraphs do not however disclose a shopping cart on the client that collects item information from the merchant web site prior to checkout as claimed in independent claim 1. Mourad does not therefore disclose each and every element of claim 1 and therefore does not anticipate claim 1.

The Office Action also states that Mourad discloses installing the electronic item through the merchandise pickup facility on the client at paragraph 1233. In fact, paragraph 1233 of Mourad discloses a selection schedule for downloading music content and describes presenting the user with the status of a download whether the user is connected or disconnected from a broadcast center. Mourad, paragraph 1233. This paragraph does not disclose installing an already downloaded electronic item through a merchandise pickup facility which is already installed on the client. Mourad does use the word ‘installation’ while describing installing client software for the digital content distribution system itself at paragraphs 0994-1013. These paragraphs address installation of the client software for the system of Mourad. These paragraphs do not disclose online shopping that includes installing an already downloaded electronic item through a merchandise pickup facility already installed on the client as claimed in independent claim 1. In fact, Mourad does not even mention a “merchandise pickup facility” and therefore cannot disclose installing an electronic item through a merchandise pickup facility. Mourad does not disclose each and every element of independent claim 1 and the rejection should therefore be withdrawn. Reconsideration of claim 1 is respectfully requested.

AUS920010628US1

Regarding newly added claims 34 and 35, claim 34 claims a client shopping cart that contains item information for an electronic item from another website and newly added 35 claims exposing the item information for an electronic item from another website in the shopping cart to the merchant web site. Mourad does not disclose client shopping carts that contain item information for an electronic item from more than one website or exposing the contents of the shopping cart to other websites. As such, Mourad does not disclose each and every element of claims 34 and 35. Applicant's therefore request the allowance of newly added claims 34 and 35.

Mourad Does Not Enable Independent Claim 1

Not only must Mourad disclose each and every element of independent claims 1 within the meaning of *Verdegaal* in order to anticipate the claim, but also Mourad must be an enabling disclosure of claim 1 within the meaning of *In re Hoeksema*. The Appellants' claims in *Hoeksema* were rejected because an earlier patent disclosed a close structural similarity to appellant's chemical compound. The court in *Hoeksema* stated: "We think it is sound law, consistent with the public policy underlying our patent law, that before any publication can amount to a statutory bar to the grant of a patent, its disclosure must be such that a skilled artisan could take its teachings in combination with his own knowledge of the particular art and be in possession of the invention." *In re Hoeksema*, 399 F.2d 269, 273, 158 USPQ 596, 600 (CCPA 1968). The meaning of *Hoeksema* for the present case is that Mourad is insufficient as anticipation under 35 USC 102(e) unless Mourad places one of ordinary skill in the art in possession of claim 1.

Currently amended independent claim 1 claims "a method of online shopping comprising the steps of: purchasing an electronic item from a merchant web site . . . wherein the purchasing is carried out by use of a client shopping cart that collects item information from the merchant web site prior to checkout . . . downloading, to the client, the electronic item through the merchandise pickup facility on the client; and installing the electronic item through the merchandise pickup facility on the client." Mourad discloses

AUS920010628US1

a method of digital content distribution using web broadcasting services generally and more particularly, Mourad discloses a system for downloading encrypted digital content. *See for example*, Mourad paragraph 0009, paragraph 0020, paragraph 0902. The Office Action states that Mourad discloses a client shopping cart at paragraphs 0282 and 0902. The cited paragraphs disclose adding an item to a shopping cart maintained by an Electronic Digital Content Store. The cited paragraphs also disclose a mixture of electronic and physical media selections in the shopping cart. The cited paragraphs do not however disclose a shopping cart on the client that collects item information from the merchant web site prior to checkout as claimed in independent claim 1. Mourad therefore does not place one of ordinary skill in the art in possession of claim 1.

The Office Action also states that Mourad discloses installing the electronic item through the merchandise pickup facility on the client at paragraph 1233. In fact, paragraph 1233 of Mourad discloses a selection schedule for downloading music content and describes presenting the user with the status of a download whether the user is connected or disconnected from a broadcast center. Mourad, paragraph 1233. This paragraph does not disclose installing an already downloaded electronic item through a merchandise pickup facility which is already installed on the client. Mourad does use the word 'installation' while describing installing client software for the digital content distribution system itself at paragraphs 0994-1013. These paragraphs address installation of the client software for the system of Mourad. These paragraphs do not disclose online shopping that includes installing an already downloaded the electronic item through a merchandise pickup facility already installed on the client as claimed in independent claim 1. In fact, Mourad does not even mention a "merchandise pickup facility" and therefore cannot place one of ordinary skill in the art in possession of installing an electronic item through a merchandise pickup facility. Mourad does not place one of ordinary skill in the art in possession of independent claim 1 and the rejection should therefore be withdrawn. Reconsideration of claim 1 is respectfully requested.

AUS920010628US1

Dependent Claims 2-11

Claims 2-11 depend from independent claim 1 and include all of the limitations of independent claim 1. Because Mourad does not disclose each and every element of claim 1 or place independent claim 1 in the possession of one of ordinary skill in the art, Mourad cannot anticipate claims 2-11. The rejection of claims 2-11 should therefore be withdrawn.

System and Computer Program Claims 12-33

The Office Action of July 6, 2004, rejects claims 12-33 on the following grounds (quoting from the Final Office Action):

Referring to claims 12-22. Claims 12-22 are rejected under the same rationale as set forth above in claims 1-11.

Referring to claims 23-33. Claims 23-33 are rejected under the same rationale as set forth above in claims 1-11.

Claims 12-22 and claims 23-33 claim respectively system and product aspects of corresponding method claims 1-11. Because Mourad does not anticipate the method claims of claims 1-11, Mourad cannot anticipate corresponding system and computer program product claims 12-33. The rejection of claims 12-33 should be withdrawn and the claims should be allowed.

AUS920010628US1

Conclusion

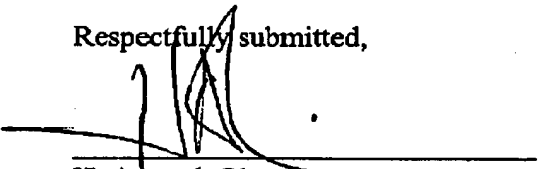
To anticipate claims 1-35, Mourad must disclose each and every element as set forth in the claims 1-35 and be an enabling disclosure of claims 1-35. Because Mourad does not disclose or place one of skill in the art in possession of a method for online shopping that includes a shopping cart that collects item information from the merchant web site prior to checkout and installing an already downloaded the electronic item through a merchandise pickup facility already installed on the client as claimed in independent claim 1, Mourad cannot anticipate claims 1-35. The rejection of claims 1-33 should be withdrawn and the case should be allowed. Applicants respectfully request the reconsideration of claims 1-33.

The Commissioner is hereby authorized to charge or credit Deposit Account No. 09-0447 for any fees required or overpaid.

Respectfully submitted,

Date: 10-6-04

By:



H. Artoush Ohanian
Reg. No. 46,022
Biggers & Ohanian, LLP
504 Lavaca Street, Suite 970
Austin, Texas 78701
Tel. (512) 472-9881
Fax (512) 472-9887
ATTORNEY FOR APPLICANTS